## Remarks

This response is filed within six months from March 15, 2006, and is filed with a request for extension of time. Claims 1-17 were pending in the application and the Examiner rejected claims 1-17. Claims 1-11 and 15-17 were rejected under 35 U.S.C. § 112. The Examiner also rejected claims 1-2 and 9-17 under 35 U.S.C. § 102(e) and claims 3-4 and 5-8 under 35 U.S.C. § 103(a). Applicants amend independent claims 1 and 15. Support for the amendments may be found in the originally filed specification, claims, and figures. No impermissible new matter has been added by these amendments. Reconsideration of the application is respectfully requested.

### *Oath/Declaration*

The Examiner noted that the oath or declaration for this application is not in compliance with 37 C.F.R. 1.67 (a). Applicants hereby submit the attached substitute declaration in compliance with 37 C.F.R. 1.67 (a). Acceptance of the substitute declaration is respectfully requested.

### *Claim Rejections -35 U.S.C. § 112*

The Examiner rejected claims 1-11 and 15-17 under 35 U.S. C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse.

The Examiner alleges that exemplary claims 1 and 15 are vague and indefinite because it "it is unclear whether the applicant seeks protection for a system and its components/elements or a method." Applicants respectfully disagree with this assessment, for the claim properly defines the structural limitations of these claims in the preamble. "A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a

structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). However, in the interest of compact prosecution, Applicants have amended claims 1 and 15. Reconsideration of the claims is respectfully requested.

***Claim Rejections – 35 U.S.C. Section 102***

The Examiner rejected claims 1-2 and 9-17 under 35 U.S.C. § 102 (e) as being anticipated by Hyman, U.S. Patent No. 6,092,047. Applicants respectfully traverse.

Hyman concerns a method and apparatus for devising the financial aspects of an employee benefits plan in accordance with goals set by either the employee and employer. The goals of Hyman include "reduc[ing] [the employer's] costs for its new plan of flexible benefits, while the employees retain as good benefits as before at no added costs to the employees." Col. 14:lns 11-13. Accordingly, Hyman is focused on a two-tiered approach in which it first optimizes employer costs of providing flexible benefit plan options and then it offers these optimized flexible benefit plan options to employees so that they can acquire good benefits without having to pay out of pocket. For example, Hyman emphasizes culling information from the employer, and only incorporating employee information if it is necessary: "obtaining either from the employer or, if necessary, polling the employees an estimate of how many employees are likely to opt down or out at a large enough incentive" (col. 7:lines 49-51).

In order to achieve its goals, Hyman employs linear programming models. (Col. 3: lines 63-67; col. 5: lines 51-54; col. 14: lines 28-67). Linear programming involves developing "a model whereby the limited resources of a business are employed to maximize profit." Col. 3 lines 56-57. For example, the linear programming models of Hyman are used "determine the

maximum val[u]e (sic) of the objective row, subject to the constraints of these eight illustrative types of linear equations or groups of linear equations." Col. 21:lines 14-16.

In contrast, the present invention involves "comparing the cost of providing [different plan design options] to the benefits of such option perceived by a group of one or more subjects." Accordingly, the present invention involves calculating a perceived benefit by providing "the subject group with information about each plan design and inquiries to elicit responses comparing each plan design option to the reference plan design option." The present invention uses a comparative or voting theory type of model that involves "calculating the average perceived benefit for each plan design option relative to the perceived benefit for the reference plan design option."

The present invention contrasts with Hyman because Hyman inputs "data relating to a census of present employees of a given employer, the various benefits selected by the employer to be considered in its financial design of a flexible benefit plan, the costs of such benefits and the employee elections with regard to opting "out" or "down" of the various benefits" (col. 5: lines 3-8) in order to devise a flexible benefit program "in accordance with the employer's objectives and priorities" (col. 5: lines 14-16.)

Accordingly, Hyman does not disclose or suggest "inputting data representative of the subject group responses" in order to "calculat[e] the average perceived benefit for each plan design option relative to the perceived benefit of the reference plan design option" as recited in independent claim 1. Nor does Hyman disclose or suggest an "input device capable of receiving data representing the identification of the plan design options, the reference plan design option, the cost of providing each option and responses of the subject group to inquiries comparing each plan design option to the reference plan design option" as recited in independent claim 13. Nor

does Hyman disclose or suggest "providing the subject group with information about each statistical factor and inquiries to elicit responses providing the relative weight of each statistical factor to be used in determining the perceived benefit of the plan design options" as recited in independent claim 15.

Claims 2 and 9-12 variously depend from independent claim 1 and contain all the elements therein, claim 14 depends from independent claim 13 and contains all the elements therein, and claims 16-17 variously depend from independent claim 15 and contain all the elements therein. Therefore, Applicants respectfully submit that claims 1-2 and 9-17 are differentiated from the cited art for at least for the same reasons as set forth above, in addition to their own respective features.

***Claim Rejections – 35 U.S.C. Section 103***

The Examiner rejected claims 3-4 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hyman. Applicants respectfully traverse.

As discussed above, Hyman specifically teaches using linear programming methods to calculate its flexible plan variables. Accordingly, Hyman does not teach or suggest using comparative models to "calculate[e] the average perceived benefit for each plan design option relative to the perceived benefit of the reference plan design option" as recited in independent claim 1.

Claims 3-4 variously depend from independent claim 1 and contain all the elements therein. Therefore, Applicants respectfully submit that claims 3-4 are differentiated from the cited art for at least for the same reasons as set forth above, in addition to their own respective features.

In addition, the Examiner rejected claims 5-8 under 35 U.S.C. § 103(a) as being unpatentable over Hyman as applied to claim 1 and further in view of Warady, U.S. Patent No. 6,067,522. The Examiner alleged that "as suggested by Hyman, one would have been motivated to include [the data displaying features of Warady] to repetitively set and reset benefit plan goals and priorities attached to these goals." Applicants respectfully traverse.

As discussed above, Hyman specifically teaches using linear programming methods to calculate its flexible plan variables. Accordingly, Hyman does not teach or suggest using comparative mathematical models to "calculate the average perceived benefit for each plan design option relative to the perceived benefit of the reference plan design option" as recited in independent claim 1.

Nor is there any motivation to combine Hyman with Warady to "repetitively set and reset benefit plan goals and priorities attached to these goals," for Warady specifically teaches away from "repetitively" setting and resetting benefit plan goals:

> In steps S6 and S7, **each employee is given a predetermined period of time during which the employee can modify the information** indicated in the confirmation if, for example, the confirmation is inaccurate or the employee changes his or her mind concerning his or her benefit plan and/or coverage option selections. **Preferably, each employee is given until the start of the plan year to make any such modifications.**"

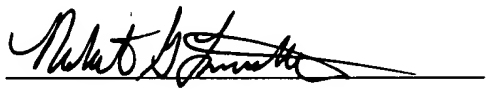
(Col. 11:lines 1-19), emphasis added.

Accordingly, neither Hyman, nor Warady, nor any combination thereof teach or suggest "readministering the inquires to the subject group to elicit revised responses comparing each plan design option to the reference plan design option; and inputting data representative of the revised responses of the subject group to the inquiries; and wherein the data representative of the revised responses is used to calculate the average perceived benefit for each plan design option," as recited in claim 5.

Claims 6-8 variously depend from claim 5 and contain all the elements therein. Therefore, Applicants respectfully submit that claims 6-8 are differentiated from the cited art for at least for the same reasons as set forth above, in addition to their own respective features.

Applicants respectfully submit that the pending claims properly set forth that which Applicants regard as their invention and are allowable over the cited art. Accordingly, Applicants respectfully request allowance of the pending claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience, if that would help further prosecution of the subject Application.

Respectfully submitted,

By: 

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